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Filed : November 21, 2003

### REMARKS

In the June 16, 2004 Office Action, the Examiner states that Claims 4, 15, 16, 18, and 25 would be allowable if rewritten in independent form; rejects Claims 20-25 under 35 U.S.C. § 112, second paragraph, as indefinite; rejects Claims 1, 19, and 20 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,566,596 to Askew ("Askew"); rejects Claims 2, 5-10, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Askew in view of U.S. Patent No. 6,455,864 to Featherby, et al ("Featherby"); and rejects Claims 3, 11, 13-18, and 21-24 under 35 U.S.C. § 103(a) as being unpatentable over Askew in view of U.S. Patent No. 5,939,772 to Hurst, et al ("Hurst"). Applicants request reconsideration of the rejections in view of the following comments and amendments.

For the purposes of responding to the Office Action, Applicants will treat all of the cited references as prior art, but Applicants reserve the right to remove one or more of the references under common ownership.

### Discussion of Allowable Subject Matter

Applicants thank the Examiner for finding that Claims 4, 15, 16, 18, and 25 would be allowable if rewritten in independent form. As will be discussed in greater detail later, in view of the patentability of Claim 1, from which Claims 4, 15, 16, and 18 depend, and the patentability of Claim 20, from which Claim 25 depends, Applicants have not rewritten Claims 4, 15, 16, 18, and 25 in this response.

### Discussion of Rejection of Claims 20-25 Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 20-25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. With respect to Claim 20, the Examiner states that the limitation "selecting a magnetic shield layer for a desired integrated circuit environment" is not clearly disclosed or described in the specification. Claims 21-25 have been rejected as depending from a rejected base claim.

In response to the rejection, Applicants have amended Claim 20 to clarify the claimed invention. In particular, Applicants have amended Claim 20 to clarify that the magnetic shield layer is selected "so that a thickness of the magnetic shield layer is tailored to a strength of an

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external magnetic field of an intended environment." Applicants believe that amended Claim 20 is supported by paragraphs [0021] and [0024].

Applicants respectfully submit that Claim 20, as amended, now complies with 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection to Claims 20-25 under 35 U.S.C. § 112, second paragraph.

**Discussion of Rejection of Independent Claims 1 and 20 Under 35 U.S.C. § 102(e) to Askew**

The Examiner rejects Claims 1 and 20 under 35 U.S.C. § 102(e) as anticipated by Askew. Applicants respectfully traverse. As will be explained in greater detail below, Applicants respectfully submit that the Examiner mischaracterizes the teachings of Askew. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," see MPEP § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In particular, the Examiner states that Figure 1 and Col. 2, lines 30-67 and Figure 3 and Col. 5, lines 15-55 of Askew teaches the invention as defined by Claim 1. Applicants respectfully submit that Askew, at Figure 3 and Col. 5, lines 15-55, does not teach or suggest "applying a film of magnetic shield material to at least one outer surface of the molded housing, the film being approximately parallel to a major surface of the semiconductor die," as claimed in Claim 1.

Applicants respectfully submit that the Examiner mischaracterizes the teachings of Askew. In particular, Applicants respectfully submit that the Examiner erroneously attributes the magnetic shielding function of the "tertiary layer 22" to the structure of a "secondary layer 24."

Rather than teaching "a film of magnetic shield material," Askew, at Figure 3 and Col. 5, lines 15-55, teaches a "secondary layer 24" that provides "electric shielding." Askew states that "[t]he secondary layer 24 functions as a *Faraday cage* to effect *electric shielding* of radiated energy from the device 12 and *reduce electric field strength* in regions outside (e.g., at 3 meters distance) the secondary layer 24 (or the device 12 or the device board). Faraday cages, as known in the art, are used to shield electric fields." Col. 5, lines 15-20 (emphasis added).

With respect to amended and clarified Claim 20, Applicants respectfully submit that Askew does not teach or suggest the invention as claimed. In particular, Askew does not teach or suggest "selecting a magnetic shield layer so that a thickness of the magnetic shield layer is

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tailored to a strength of an external magnetic field of an intended environment," as recited by amended Claim 20. In addition, Applicants note that Askew, at Col. 5, lines 15-55, relates to an electric field shield and not to a magnetic field shield as discussed earlier in response to the rejection of Claim 1.

Therefore, Applicants respectfully maintain that Askew does not teach or suggest Applicants' invention as defined by Claim 1 or 20, and Applicants request allowance of Claims 1 and 20.

#### Discussion of Rejection of Dependent Claims 2, 3, 5-14, 17, 19, and 21-24

Dependent Claims 2, 3, 5-14, 17, and 19 depend from and further define Claim 1. Dependent Claims 21-24 depend from and further define Claim 20. The dependent claims recite numerous additional distinctions over the cited references.

For example, dependent Claim 17 describes "retaining the film of magnetic shield material within a recess formed in the molded housing." Dependent Claim 21 describes "forming a recess in a major surface of the encapsulant, wherein applying comprises fitting the selected magnetic shield layer within the recess." Applicants respectfully submit that a combination of Askew and Hurst does not teach or suggest Claims 17 or 21.

In addition, Applicants respectfully submit that a combination of Askew and Featherby does not teach or suggest the invention as defined by Claims 2, 5-10, and 12, and that a combination of Askew and Hurst does not teach or suggest the invention as defined by Claims 3, 11, 13-18, and 21-24. In order "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). See M.P.E.P. §2143.03.

For example, rather than teaching magnetic shielding, Featherby "relates in general to a *radiation shielding* coating composition and a method of making and using it," Col. 1, lines 33-35 (emphasis added). Featherby explains that "[t]he radiation effects include solar flares, galactic cosmic radiation and the Van Allen trapped electron and proton belts or man-made

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radiation induced events (neutrons and gamma radiation)," see Col. 1, lines 50-53. Accordingly, Applicants respectfully submit that a combination of Askew and Featherby does not teach or suggest the "applying a film of magnetic shield material to at least one outer surface of the molded housing" as recited in Claim 1, or "selecting a magnetic shield layer so that a thickness of the magnetic shield layer is tailored to a strength of an external magnetic field of an intended environment," as recited in amended Claim 20, from which the dependent claims depend.

With respect to Hurst, Applicants note that element 10 of Hurst does not correspond to a "molded housing 10" as stated by the Examiner, but rather, "package 10 includes a base 12 and a lid 14," see Col. 1, line 67 to Col. 2, line 1. Hurst describes "a completely inorganic packaging approach," see Col. 2, line 51. Hurst further describes that "it is desirable to have a hermetically sealed package that is free from any internal organic materials such as epoxy materials," see Col. 1, lines 37-39. Accordingly, Hurst teaches not to use molding materials, such as epoxy. Therefore, Applicants respectfully submit that it is improper to combine Askew and Hurst because Hurst teaches away from "forming a molded housing" as recited in Claim 1, or "molding epoxy" as recited in amended Claim 20. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983), M.P.E.P. § 2145(X)(D)(2). Applicants further respectfully submit that even if Askew and Hurst were to be combined, such a combination would not teach or suggest the invention as claimed. For example, the combination would not teach or suggest "applying a film of magnetic shield material to at least one outer surface of the molded housing" as recited in Claim 1, or "selecting a magnetic shield layer so that a thickness of the magnetic shield layer is tailored to a strength of an external magnetic field of an intended environment," as recited in amended Claim 20, from which the dependent claims depend.

In addition, Applicants respectfully submit that the rejections to dependent Claims 2, 3, 5-14, 17, 19, and 21-24 are moot in light of the patentability of Claims 1 and 20, respectively, and Applicants accordingly request allowance of Claims 2, 3, 5-14, 17, 19, and 21-24.

### Summary

In view of the foregoing remarks, Applicants respectfully request the Examiner to withdraw the rejections of Claims 1-3, 5-14, 17, and 19-21 under 35 U.S.C. § 102(b) and 35

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U.S.C. § 103(a). Applicants further request the Examiner to allow Claims 1-25 and to pass the present application to the issue process.

If there is any further impediment to the prompt allowance of the present application, Applicants request the Examiner to call the undersigned attorney of record at 310-407-3466 or at the telephone number listed below to resolve any such impediment.

Respectfully submitted,

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Dated: Sept. 15, 2004

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